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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,155	04/01/2004	Barry W. Townsend	183.39735AP7	7370
20457	7590	10/11/2007		
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			EXAMINER BLANCO, JAVIER G	
			ART UNIT 3774	PAPER NUMBER
			MAIL DATE 10/11/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/814,155	TOWNSEND ET AL.	
	Examiner	Art Unit	
	Javier G. Blanco	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 7, 9-11, 15, 16, 18, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6, 7, 9-11, 15, 16, 18 and 23-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/3/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendment***

1. Applicants' amendment of claims 1, 6, 7, 10, and 15 in the reply filed on August 3, 2007 is acknowledged.
2. Applicants' cancellation of claim 13 in the reply filed on August 3, 2007 is acknowledged.
3. Applicants' addition of claims 25 and 26 in the reply filed on August 3, 2007 is acknowledged.

***Terminal Disclaimer***

4. The terminal disclaimer filed on August 3, 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 7,108,723 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 6, 9-11, 15, 16, 18, and 23-26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by GOMED (DE 299 20 434 U1; cited in Applicants' IDS).

Referring to Figures 1 and 2, GOMED discloses a prosthetic foot comprising:

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(i) A longitudinally extending foot keel having a forefoot portion (3), a raised midfoot portion (19), and a hindfoot portion (10); and

(ii) A resilient, monolithically formed shank (spring 5) extending upwardly from the foot keel by way of an anterior facing continuous convexly curved surface (**first interpretation:** the “surface” is any of the anterior or posterior surfaces of inner leaf 12; **second interpretation:** the “surface” is any of the anterior or posterior surfaces of outer leaf 11) which extends over at least most of the length of the shank and has increasing radius of curvature *to form* an ankle joint area (bottom half of spring 5) and a curvilinear prosthetic part of a leg (upper half of spring 5) extending substantially upward above the ankle joint area, the shank having a proximal portion (**first interpretation:** upper free end 8; **second interpretation:** spring loop 18; **third interpretation:** lower component 16); wherein the ankle joint area and the prosthetic part of a leg formed by the shank are anterior facing convexly curved; wherein the shank and at least the hindfoot portion of the foot keel are monolithically formed (see Figure 1); and wherein the width of the resilient member in the frontal plane in the prosthesis is greater than the thickness of the resilient member in the sagittal plane throughout the entire length of the resilient member (compare Figure 1 to Figure 2). The shank and foot keel are formed of titanium or carbon material (see claims 12 and 13).

With regard to statements of intended use and other functional statements (e.g., configured to; adapted to; for insertion; etc.), they do not impose any structural limitations on the claims distinguishable over the device of GOMED, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in

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terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

7. Claims 1, 6, 7, 9-11, 15, 16, 18, 23, and 24 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Allen et al. (US 5,653,767; cited in Applicants’ IDS).

Referring to Figures 1 and 6, Allen et al. disclose a prosthetic foot comprising:

- (i) A longitudinally extending foot keel having a forefoot portion (42), a raised midfoot portion (40), and a hindfoot portion (26); and
- (ii) A resilient, monolithically formed shank extending upwardly from the foot keel by way of an anterior facing continuous convexly curved surface (the “surface” is any of the anterior or posterior surfaces of arcs 24) which extends over at least most of the length of the shank and has increasing radius of curvature *to form* an ankle joint area (bottom half of anterior arc 44) and a curvilinear prosthetic part of a leg (upper half of anterior arc 44) extending substantially upward above the ankle joint area, the shank having a proximal portion (**first interpretation:** a proximal portion of anterior arc 44); wherein the ankle joint area and the prosthetic part of a leg formed by the shank are anterior facing convexly curved; and wherein the shank and at least the hindfoot portion of the foot keel are monolithically formed (see Figures 1 and 6). The shank and foot keel are formed of metal or plastic.

With regard to statements of intended use and other functional statements (e.g., configured to; adapted to; for insertion; etc.), they do not impose any structural limitations on the claims distinguishable over the device of Allen et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

8. Claims 1, 2, 6, 7, 9-11, 15, 16, 18, and 23-26 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Allen (US 5,443,528; cited in Applicants’ IDS).

Referring to Figures 1, 2, 5, 6a, and 8, Allen discloses a prosthetic foot (101) comprising:

(i) A longitudinally extending foot keel having a forefoot portion (116), a raised midfoot portion (114), and a hindfoot portion (115); and

(ii) A resilient, monolithically formed shank (anterior coil spring section 103) extending upwardly from the foot keel by way of an anterior facing continuous convexly curved surface (the “surface” is any of the anterior or posterior surfaces of anterior coil spring section 103) which extends over at least most of the length of the shank and has increasing radius of curvature *to form* an ankle joint area (bottom half of anterior coil spring section 103) and a curvilinear

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prosthetic part of a leg (upper half of anterior coil spring section 103) extending substantially upward above the ankle joint area, the shank having a proximal portion (e.g., a proximal “portion” of anterior coil spring section 103); wherein the ankle joint area and the prosthetic part of a leg formed by the shank are anterior facing convexly curved; wherein the entire foot keel and the shank are monolithically formed (see column 4, lines 49-51); and wherein the width of the resilient member in the frontal plane in the prosthesis is greater than the thickness of the resilient member in the sagittal plane throughout the entire length of the resilient member (compare Figure 1 to Figure 2). The anterior facing convexly curved surface extends the entire length of the shank (i.e., the front surface is anterior facing and convexly curved). The shank and foot keel are formed of metal or plastic.

With regard to statements of intended use and other functional statements (e.g., configured to; adapted to; for insertion; etc.), they do not impose any structural limitations on the claims distinguishable over the device of Allen, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

***Response to Arguments***

9. Applicants' arguments with respect to claims 1 and 10 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:00 a.m.-7:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular



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communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Javier G. Blanco

October 8, 2007



David H. Willse  
Primary Examiner